Docket No.:   1536.1002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Hisashi SAKAKIBARA

Serial No. 09/632,586   Group Art Unit: 2177

Confirmation No. 1897

Filed: August 4, 2000   Examiner: S. T. Channavajjala

For: POINT MANAGING METHOD, POINT MANAGING SYSTEM, CENTRAL UNIT AND
RECORDING MEDIUM

<u>AMENDMENT</u>   **RECEIVED**

Commissioner for Patents   JUL 0 2 2003
PO Box 1450
Alexandria, VA 22313-1450   Technology Center 2100

Sir:

This is in response to the Office Action mailed March 25, 2003, and having a period for response set to expire on June 25, 2003.

The following amendments and remarks are respectfully submitted. Reconsideration of the claims is respectfully requested.

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IN THE CLAIMS:

All pending claims are set forth below. Cancelled and withdrawn claims are indicated with claim number and status only. The claims as listed below show added text with <u>underlining</u> and deleted text with ~~strikethrough~~. The status of each claim is indicated with one of (original), (currently amended), (previously amended), (cancelled), (withdrawn), (new), (previously added), (reinstated - formerly claim #), (previously reinstated), (re-presented - formerly dependent claim #), or (previously re-presented).

Please AMEND the claims in accordance with the following:

1.   (ORIGINAL) A point managing method for managing points among a first business entity, a second business entity who cooperates with said first business entity and customers of the first and second business entities, said first business entity managing communication points used for on-line services, said second business entity managing valuable points given to customers as a reward for consumption activity, said method comprising the steps of:

instructing said first business entity by said customer to exchange valuable points for communication points;

requesting said second business entity by said first business entity to send valuable points given to the customer, according to the instruction;

sending requested valuable points by said second business entity to said first business entity; and

exchanging received valuable points for communication points by said first business entity, according to a preset exchange rate.

2.   (ORIGINAL) A point managing system comprising a central unit for managing communication points used for on-line services, a cooperate-use terminal unit that is connected to said central unit and manages valuable points representing a reward for consumption activity, and a customer-use terminal unit that is connected to said central unit, wherein

said customer-use terminal unit comprises a controller capable of performing the operation of transmitting to said central unit exchange instructing information instructing an exchange of valuable points for communication points,

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said central unit comprises:

a communication point database that records information related to communication points;

an exchange database that records information related to an exchange rate between communication points and valuable points; and

a controller capable of performing the operation of transmitting to said cooperate-use terminal unit valuable point request information requesting valuable points corresponding to the customer-use terminal unit according to received exchange instructing information; and

said cooperate-use terminal unit comprises:

a valuable point database that records information related to valuable points;

a controller capable of performing the following operations:

transmitting to said central unit valuable points;

corresponding to received valuable point request information; and

updating the valuable point database according to the transmitted valuable points; and

said controller of the central unit further capable of performing following operations:

exchanging received valuable points for communication points according to an exchange rate recorded in said exchange database; and

updating said communication point database according to the exchanged communication points.

3.   (ORIGINAL) The point managing system as set forth in claim 2, wherein

said controller of the customer-use terminal unit further capable of performing following operations:

accepting input of first identification information related to customers and second identification information that is different from said first identification information; and

transmitting said first and second identification information to said central unit;

said controller of the central unit further capable of performing the following operations:

authenticating said customer-use terminal unit based on received first identification information; and

transmitting received second identification information to said cooperate-use terminal unit;

said valuable point database provided in said cooperate-use terminal unit stores valuable points recorded to correspond to the second identification information; and

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said controller of the cooperate-use terminal unit further capable of performing the operation of extracting from the valuable point database valuable points to be transmitted to said central unit, according to received second identification information.

4.   (ORIGINAL) A central unit connected to a cooperate-use terminal unit for managing valuable points representing a reward for consumption activity and a customer-use terminal unit, for managing communication points used for on-line services, comprising:

a communication point database that records information related to communication points;

an exchange database that records information related to an exchange rate between communication points and valuable points; and

a controller, coupled to said communication point database and said exchange database, and capable of performing the following operations:

when exchange instructing information instructing an exchange of valuable points for communication points is received, for transmitting to said cooperate-use terminal unit valuable point request information requesting valuable points corresponding to the customer-use terminal unit according to the received exchange instructing information;

when valuable points corresponding to the transmitted valuable point information are received, for exchanging the received valuable points for communication points according to an exchange rate recorded in said exchange database; and

updating said communication point database according to the exchanged communication points.

5.   (ORIGINAL) A computer readable recording medium including thereon a recorded computer program for causing a computer having communication means to manage communication points used for on-line services, comprising:

computer readable program code means, when exchange instructing information instructing an exchange of valuable points representing a reward for consumption activity for communication points is received, for causing a computer to transmit valuable point request information requesting valuable points to said communication means corresponding to the requested valuable points, according to said exchange instructing information; and

computer readable program code means, when valuable points corresponding to the transmitted valuable point request information are received, for causing a computer to exchange

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the received valuable points for communication points according to a preset exchange rate.

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6.   (NEW) A method of exchanging points between different business entities, comprising:

responsive to a customer purchasing a good or service from a first business entity that offers various types of goods or services, automatically crediting to the customer non-monetary first points of a type issued by the first business entity, where the first business entity agrees to, upon conditions, redeem to the customer the credited non-monetary first points in exchange for any of the goods or services of the various types offered by the first business entity; and

in response to an interactive request of the customer, exchanging the credited non-monetary first points for non-monetary second points of a type issued by a second business entity which are credited to the customer, where the second business entity agrees to, upon conditions, redeem to the customer the credited non-monetary second points in exchange for any of goods or services of various types offered by the second business entity, where the first points and the second points are of types that are not fungible.

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7.   (NEW) A method according to claim 6, wherein the exchanging further comprises de-crediting the first points from the customer.

8.   (NEW) A method according to claim 6, wherein the first points and second points are exchanged according to electronic exchange rate information.

9.   (NEW) A method according to claim 6, wherein the first points are only directly redeemable by the first business entity, and wherein the second points are only directly redeemable by the second business entity.

REMARKS

INTRODUCTION

Claims 1-5 were previously pending and under consideration.

Claims 1-5 have been rejected.

Claims 6-9 have been added.

Therefore, claims 1-9 are now pending and under consideration.

No new matter is being presented, and approval and entry are respectfully requested.

REQUEST FOR CONSIDERATION OF PREVIOUSLY SUBMITTED INFORMATION DISCLOSURE STATEMENT (IDS)

The previously submitted IDS must be considered. Rule 1.98(a)(3)(i) requires a concise explanation of the relevance of the references. This was provided. Rule 1.98(a)(3)(ii) requires an English translation if such "is within the possession, custody, or control of, or is readily available [to Applicant, etc.]". Therefore, there is no basis for requiring an English translation or refusing to consider the IDS. Furthermore, no Rule was cited for refusing to consider the IDS. If the IDS is again not considered, Applicant respectfully requests the Examiner to cite the authority or Rule supporting such refusal.

For the convenience of the Examiner, included herewith is a photocopy of the originally filed IDS that included the concise explanations, as verified by the returned postcard.

REJECTIONS UNDER 35 USC § 103

In the Office Action, claims 1-5 were rejected under 35 U.S.C. § 103 as obvious over Horstmann in view of Walker. This rejection is traversed and reconsideration is requested.

HORSTMANN DOES NOT TEACH "BUSINESS ENTITIES" ACCORDING TO THE PLAIN MEANING OF "BUSINESS ENTITIES"

MPEP § 2111.02 states that "words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification", and "[c]laims are not to be read in a vacuum, and limitations therein are to be interpreted in light of the specification in giving them their 'broadest reasonable interpretation". The Merriam-Webster Dictionary notes that "business" can be used to indicate "a usually commercial or mercantile activity engaged in as a means of livelihood : TRADE, LINE <in the restaurant business> b : a commercial or sometimes an industrial enterprise; also : such enterprises <the business district> c : usually economic dealings : PATRONAGE <took their business elsewhere>". The same dictionary also notes that "entity" can be used to indicate "BEING, EXISTENCE; especially : independent, separate, or self-contained existence b : the existence of a thing as contrasted with its attributes 2 : something that has separate and distinct existence and objective or conceptual reality".

It is respectfully submitted that the rejection based on Horstmann is incorrect because it relies on an unreasonable interpretation of "business entity" that does not reflect its plain meaning and which is not reasonable in light of the specification. The claims recite a "business entity". The entire specification indicates that a "business entity" is a real-world business, such as an airline, online service provider, credit card company, etc. This meaning is in firm agreement with the ordinary meaning of a "business entity". A search of www.google.com readily reveals that the common and ordinary meaning of "business entity" is an actual business, such as a corporation, sole proprietor (human being), etc.

In contrast, "business entity" in Horstmann refers to an object class of a computer program, as would be implemented with an object broker such as CORBA. Horstman's Figure 3 and its description thereof clearly indicate that Horstmann uses "business entity" as shorthand to refer to an instantiated object of a business entity object class. See also page 5, lines 22-24 of Horstman: "a copy of a business entity is modified **on one of the computers,** the other copies of the business entity are automatically updated to ensure data consistency." Although implementations of the present invention may involve information for representing business entities, the claims themselves recite features of actual or real-world business entities (e.g. "customers of the first and second business entities" (claim 1). In sum, the rejection improperly uses Horstmann's private and uncommon meaning of "business method" to give an unreasonable and uncommon meaning to the term as recited in the present claims. Horstmann does not teach "business entities" as recited in the pending claims, and Walker was not cited for

and does not teach or suggest the same.

WALKER DOES NOT TEACH EXCHANGING POINTS OF ONE BUSINESS ENTITY FOR POINTS OF ANOTHER BUSINESS ENTITY

Claim 1, for example, recites "exchanging received valuable points for communication points by said first business entity, according to a preset exchange rate". From the language of the claim, it is clear that the "exchange rate", is a rate used for "exchanging ... points ... for ... points". Walker does not discuss exchanging points for points and does not discuss an exchange rate for the same. The rejection cites col. 4, lines 49-61 of Walker. However, this portion of Walker discusses distribution of a single business entity's points to different members or users of a given account. The "rate" of Walker is only the proportion of distribution; no exchange of points is involved. That is, claim 1 recites exchanging one entity's points for another entity's points according to an exchange rate. This is not the same as exchanging points of a first entity for points of a second entity.

The above understanding of Walker is further supported by col. 1, lines 65-67 of Walker, which indicate that Walker addresses a "fail[ure] to allow multiple users to utilize a single account card". Therefore, Walker discusses "rewarding" by giving points to customers that accompany a "frequent shopper", such as a family member, spouse, and the like. In other words, Walker only discusses points issued by a single business entity.

Withdrawal of the rejection of claims 1-5 is respectfully requested.

IMPROPER COMBINATION

The combination of Walker with Horstmann is improper because they are from non-analogous art. MPEP § 2141.01(a) states that, with regard to whether art is analogous, "the similarities and differences in structure and function of the inventions . . . carry far greater weight [thant PTO classification]". Horstmann relates to a system of distributed object collaboration. Walker relates to a multiple party reward system. These references are from non-analogous art. Furthermore, there are significant differences in their function and structure. Horstmann teaches a multi-tier object architecture (see. Figure 7). Walker teaches an ordinary transaction processing system (see Figure 1). Horstmann teaches a function of mirroring copies of an object. Walker teaches a function of allocating rewards/points to different users of a same account. Horstmann and Walker differ significantly in structure and function, therefore they are

non-analogous and there is no motive for their combination.

Withdrawal of the rejection of claims 1-5 is respectfully requested.

FUTHER REJECTION MUST BE NON-FINAL

It is respectfully noted that the previously pending claims 1-5 have not been amended. Any new grounds for their rejection cannot have been necessitated by their amendment. Therefore, it is respectfully submitted that any next Office Action further rejecting these claims must be made non-Final.

DEPENDENT CLAIM 2

The dependent claim 2 is deemed patentable due at least to its dependence from allowable independent claim 1. This claim is also patentable due to its recitation of independently distinguishing features. For example, claim 2 recites "a controller capable of performing the operation of transmitting to said cooperate-use terminal unit valuable point request information requesting valuable points corresponding to the customer-use terminal unit according to received exchange instructing information". This feature is not taught or suggested by the prior art. Withdrawal of the rejection of the dependent claims is respectfully requested.

NEW CLAIMS

New claims 6-9 have been added to recite another aspect of the present invention in alternative language. As noted above, the cited prior art does not discuss different business entities exchanging points. Furthermore, the cited prior art does not mention or suggest that "first points and ... second points [that] are of types that are not fungible". The disbursed points of Walker are from a single vendor and are clearly fungible.

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

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Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 25 June 2003

By: _____
James T. Strom
Registration No. 48,702

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Washington, D.C. 20001
(202) 434-1500

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IDS, Form PTO-1449; 3 references and Statement of Relevance

Horishi IKEDA

Applicant(s): PUSH SERVICE SYSTEM AND PUSH SERVICE PROCESSING METHOD

Title: 09/632,586

Serial No.: April 4, 2000

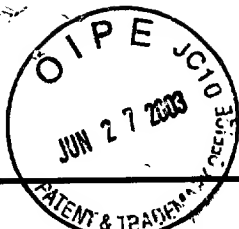**Filing Date:** 1536.1002 (JDH)

Docket No.: n/a

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REPLY/AMENDMENT FEE TRANSMITTAL

Attorney Docket No.	1536.1002
Application Number	09/632,586
Filing Date	August 4, 2000
First Named Inventor	Hisashi SAKAKIBARA
Group Art Unit	2177

AMOUNT ENCLOSED	$84.00	Examiner Name	S. T. Channavajjala

FEE CALCULATION (fees effective 01/01/03)

CLAIMS AS AMENDED	Claims Remaining After Amendment	Highest Number Previously Paid For	Number Extra	Rate	Calculations
TOTAL CLAIMS	9	- 20 =	0	X $ 18.00 =	$ 0.00
INDEPENDENT CLAIMS	5	- 4 =	1	X $ 84.00 =	84.00

Since an Official Action set an <u>original</u> due date of <u>June 25, 2003</u> , petition is hereby made for an extension to cover the date this reply is filed for which the requisite fee is enclosed (1 month ($110); 2 months ($410); 3 months ($930); 4 months ($1,450); 5 months ($1,970)):	
If Notice of Appeal is enclosed, add ($320.00)	
If Statutory Disclaimer under Rule 20(d) is enclosed, add fee ($110.00)	
Information Disclosure Statement (Rule 1.17(p)) ($180.00)	
Total of above Calculations =	$ 84.00
Reduction by 50% for filing by small entity (37 CFR 1.9, 1.27 & 1.28)	
TOTAL FEES DUE =	$ 84.00

(1) If entry (1) is less than entry (2), entry (3) is "0".
(2) If entry (2) is less than 20, change entry (2) to "20"
(4) If entry (4) is less than entry (5), entry (6) is "0".
(5) If entry (5) is less than 3, change entry (5) to "3".

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☐ No payment is enclosed and no charges to the Deposit Account are authorized at this time (unless specifically required to obtain a filing date).

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☒ If the above-noted "AMOUNT ENCLOSED" is not correct, the Commissioner is hereby authorized to credit any overpayment or charge any additional fees necessary to:

Deposit Account No.	19-3935
Deposit Account Name	STAAS & HALSEY LLP

☒ The Commissioner is also authorized to credit any overpayments or charge any additional fees required under 37 CFR 1.16 (filing fees) or 37 CFR 1.17 (processing fees) during the prosecution of this application, including any related application(s) claiming benefit hereof pursuant to 35 USC § 120 (e.g., continuations/divisionals/CIPs under 37 CFR 1.53(b) and/or continuations/divisionals/CPAs under 37 CFR 1.53(d)) to maintain pendency hereof or of any such related application.

SUBMITTED BY: STAAS & HALSEY LLP

Typed Name	James T. Strom	Reg. No.	48,702
Signature	*James Strom*	Date	25 June 2003

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By: *Naomi Anderson*
Date : ___June 25, 2003___